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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,940	02/10/2004	Toerless Eckert	112025-0821	4233
24267 7590 05/22/2009 CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210				
EXAMINER				
POLLACK, MELVIN H				
ART UNIT		PAPER NUMBER		
2445				
MAIL DATE		DELIVERY MODE		
05/22/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/776,940

**Applicant(s)**

ECKERT, TOERLESS

**Examiner**

MELVIN H. POLLACK

**Art Unit**

2445

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-32 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Individual Patent Application  
6) ☒ Other: see attached office action

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 02 March 2009 have been fully considered but they are not persuasive. An analysis of the arguments is provided below.
2. Applicant's primary argument is that Suzuki does not separate groups by type such that different types get different addresses (Pp. 10-11). Instead, applicant focuses on request translation and on source addressing, and therefore misses Suzuki's differential treatment between the two types.
3. In response to applicant's argument that Applicant's techniques are to keep the types separate or to make the system look like different hosts (P. 10), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.
4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the narrow example of type separation such as to fool the router) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims must be read in accordance with their broadest reasonable interpretation in accordance to one of ordinary skill in the art, and this includes temporal aspects as well as interpretations of separation of groups by type.

5. The cited paragraphs make clear that the SSM packet and the ASM packet is treated differently, such that the packets ultimately attach different source addresses. That this is done as a form of translation rather than to fool the router that they are two different hosts is irrelevant, given the current structure and functionality of the claims. Furthermore, it is presumed that there is a need by the router to understand both incompatible types. To amend around Suzuki, applicant requires further structural and functional limitations clarifying the separating steps or the functionality of the receiving router.

6. Therefore, the rejection is maintained for the reasons above. This rejection is final.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (2004/0100983) in view of Watanuki et al. (6,853,639).

9. For claims 1, 8, 15, and 22, Suzuki teaches a method and system (abstract) for providing request compatibility in a multicast system (Paras. 1-41 and 88), said method comprising:

- a. Receiving (Paras. 42-44), by a translator coupled between a group of receivers and a router (Paras. 80-81), requests for traffic from said group of receivers (Para. 47);
- b. determining, by said switch, whether said traffic requests contain incompatible request types (Para. 62);

- c. if incompatible request types exist (Paras. 63-66), then separating said traffic requests into at least two groups based on type (Paras. 49-60); and
  - d. sending requests of different types to said router from different addresses of the translator (Paras. 63-67), to present an appearance to said router that the requests of different types are from different hosts (Paras. 75-77).
10. Suzuki does not expressly disclose that the translator is a layer 2 switch. Watanuki teaches a method and system (abstract) of performing request compatability in a multicast system (col. 1, line 1 – col. 5, line 55; col. 15, line 40 – col. 16, line 45) wherein an L2 switch is interposed between the router and a receiver (col. 5, line 55 – col. 6, line 40) to perform differentiation (col. 6, line 65 - col. 7, line 15) and conversion (col. 7, lines 15-40; col. 7, line 55 – col. 8, line 60) by address manipulation (col. 9, lines 5-65). At the time the invention was made, one of ordinary skill in the art would have added Watanuki to Suzuki, both of the same assignee, in order to improve Suzuki's goal (Suzuki, Paras. 15-17) of decreasing traffic (Watanuki, col. 2, lines 1-15).
11. For claims 2, 9, 16, and 23, Suzuki teaches that said incompatible request types include a single-source request and an any-source request (Para. 42).
12. For claims 3, 10, 17, and 24, Suzuki teaches that said single-source request comprises an IGMP v3 request (Para. 49).
13. For claims 4, 11, 18, and 25, Suzuki teaches that said any-source request comprises an IGMP v2 request (Para. 49).
14. For claims 5, 12, 19, 26, 30, 31, Suzuki teaches that said incompatible request types include an include request (join) and an exclude request (leave) (Para. 58).

15. For claims 6, 13, 20, and 27, Suzuki does not expressly disclose the usage of MAC addresses. Watanuki teaches that said act of sending requests of different types to said router from different addresses further comprises creating a first host identity located at a first MAC address and creating a second host identity located at a second MAC address (col. 9, line 25 – col. 12, line 5).

16. For claims 7, 14, 21, and 28, Suzuki does not expressly disclose the usage of MAC addresses. Watanuki teaches that sending requests of a first type from said first host identity located at said first MAC address, and sending requests of a second type from said second identity located at said second MAC address (col. 6, line 65 – col. 8, line 15).

17. For claim 29, Suzuki teaches a method (abstract; Paras. 1-41 and 88) comprising:

- a. Receiving (Paras. 42-44), by a translator coupled between a group of receivers and a router (Paras. 80-81), a plurality of Internet Group Multicast Protocol (IGMP) requests (Para. 47);
- b. determining, by the switch (Para. 62), that the plurality of IGMP requests include both IGMP requests of a first type and IGMP requests of a second type (Para. 49);
- c. separating the plurality of IGMP requests into at least two groups (Paras. 49 – 60) based on their type (Paras. 63-66), a first group to include the IGMP requests of the first type and a second group to include the multicast IGMP requests of the second type (Paras. 42, 49); and
- d. sending, by the switch, the source multicast IGMP requests of the first group to the router using a first Media Access Control (MAC) address assigned to the switch and sending source-specific multicast IGMP requests of the second group to the router using

a second MAC address assigned to the switch, the second MAC address different from the first MAC address (Paras. 63-67), to present an appearance to the router that the IGMP requests of the first type and the IGMP requests of the second type are from different hosts (Paras. 75 – 77).

18. Suzuki does not expressly disclose that the translator is a layer 2 switch. Watanuki teaches a method and system (abstract) of performing request compatability in a multicast system (col. 1, line 1 – col. 5, line 55; col. 15, line 40 – col. 16, line 45) wherein an L2 switch is interposed between the router and a receiver (col. 5, line 55 – col. 6, line 40) to perform differentiation (col. 6, line 65 - col. 7, line 15) and conversion (col. 7, lines 15-40; col. 7, line 55 – col. 8, line 60) by address manipulation (col. 9, lines 5-65). At the time the invention was made, one of ordinary skill in the art would have added Watanuki to Suzuki, both of the same assignee, in order to improve Suzuki's goal (Suzuki, Paras. 15-17) of decreasing traffic (Watanuki, col. 2, lines 1-15).

19. As for claim 32, Suzuki teaches separately aggregating, by the router, the IGMP requests of the first type and the IGMP requests of the second type (Para. 42).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELVIN H. POLLACK whose telephone number is (571)272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. H. P./  
Examiner, Art Unit 2445  
15 May 2009

/Larry D Donaghue/  
Primary Examiner, Art Unit 2454